

REMARKS

Reconsideration is requested.

Objected to claim 86 has been placed in independent form.

Claims 44-84 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,275,476. However, no double patenting rejection was made against claims 85-124. Clarification was requested in a telephonic Examiner Interview with the Examiner that occurred on May 10, 2005. Applicant's attorney asked Examiner Hyun to confirm that he did not intend to make a double patenting rejection against claims 85-124. The Examiner stated that Applicant's attorney should respond to the rejections as were made in the Office Action. Therefore, claims 44-84 have been cancelled and no Terminal Disclaimer will be filed in this application. Applicant's attorney plans to file a continuation application directed to the subject matter of the cancelled claims.

Claims 85, 87-96, 114-118, 123, and 124 stand rejected as being unpatentable over U.S. Patent No. 5,500,640 to Snodgrass et al., in view of Applicant's Admitted Prior Art (AAP).

The Examiner is alleging that it would have been obvious to one having ordinary skill in the art to combine the slotted Aloha arbitration scheme (AAP) into Snodgrass et al. to improve transmission efficiency with less collision than a pure Aloha.

Applicant respectfully traverses the rejections.

Referring to MPEP §2146(j)(3), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill

in the art, to modify or combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Obviousness cannot be established by a combination of references unless there is some motivation in the art to support the combination. (See *ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.")). The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).

The Snodgrass et al. patent and Applicant's admitted prior art have been improperly combined to formulate the obviousness rejections. There is no teaching or suggestion in the prior art itself to combine the prior art references. No such teaching or suggestion exists in the prior art to motivate one of ordinary skill in the art to combine the references, nor has such been identified in the Office Action. The Examiner's thoughts as to why it may be advantageous to do so constitute impermissible hindsight reconstruction based solely on Applicant's disclosure--there is no teaching or suggestion in the prior art to make any such combination. In view of the above, the teachings of the Snodgrass et al. patent

cannot be combined with the teachings of Applicant's admitted prior art absent some suggestion or motivation. What teaching in the prior art would motivate someone of ordinary skill in the art to modify Snodgrass et al., and why would one of ordinary skill in the art choose one protocol over another?

Any obviousness rejection based upon the Snodgrass et al. patent and Applicant's admitted prior art only results from improper hindsight reconstruction. It would not be obvious to combine the Snodgrass et al. patent with Applicant's admitted prior art because there is no teaching or suggestion in the prior art itself as to which prior art protocol should be selected and somehow combined with the Snodgrass et al. patent. The obviousness rejections are improper for at least this reason. There is no teaching or suggestion in the admitted prior art or in Snodgrass et al. that some advantage would result from using a slotted Aloha protocol as opposed to any other type of protocol. Therefore, it would not be obvious to use a slotted Aloha technique. Therefore, the combination of references is improper.


The rejection of claims 85, 87-96, 114-118, 123, and 124 as being unpatentable over U.S. Patent No. 5,500,640 to Snodgrass et al., in view of Applicant's Admitted Prior Art (AAP) should be withdrawn because the combination of references is improper.

Applicant herewith submits a duplicate copy of a Supplemental Information Disclosure Statement and Form PTO 1449, filed on May 14, 2001 of which it does not yet have an initialed copy from the Examiner. To the extent the PTO 1449 has not already been initialed in the file, such examination and initialing is requested at this time, and returning of a copy to the undersigned is respectfully requested.

The Examiner is requested to telephone the undersigned in the event that the next office action is one other than a Notice of Allowance. The undersigned is available for telephone consultation at any time.

Respectfully submitted,

Dated: May 27, 2005

By: 
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